

Docket No.: ARUMI
Serial No.: 09/935,869

REMARKS

The last Office Action of May 14, 2004 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Reconsideration of the instant application in view of the newly presented claim 21 is respectfully requested.

Claims 1-21 are pending in the application. No claims have been canceled. New claim 22 has been added. A total of 22 claims are now on file. The claim surcharge for one independent claim of not more than 3, is paid through Deposit Account No. 06-0502.

Claims 1, 7, 9, 10, 11, 15 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,222,973 (hereinafter "Sharpe").

Claim 21 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,486,185 (hereinafter "Freitas").

Claims 2-6 stand rejected under 35 U.S.C. §103(a) as being obvious over Sharpe in view of U.S. Pat. No. 5,746,770 (hereinafter "Zeitels").

Applicant acknowledges with appreciation that claims 8, 12-14 and 17-20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. However, applicant wishes to defer allowance until such time that the amended claims have been examined and applicant's arguments and new claim 22 has been further examined.

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AMENDMENTS TO THE SPECIFICATION

Applicant has also amended the specification to correct three obvious translational errors. No new matter has been introduced.

REJECTION OF CLAIMS 1, 7, 9, 10, 11, 15 and 16 UNDER 35 U.S.C. §102(b) AS BEING ANTICIPATED BY SHARPE

The rejection under 35 U.S.C. 102(b) is respectfully traversed.

The Examiner has recited all structures in claim 1 and alleges that Sharpe discloses same pointing to Fig. 3. However, the head piece in claim 1 is different from the Sharpe head piece. The head piece as claimed has tapering arms as is seen from FIG. 7 in the application. Sharpe does not show that feature. Therefore Sharpe does not anticipate the invention as claimed in claim 1. The amendments made to claim 1 relate to the axial position of the rod within the probe. Furthermore, the word grasping has been changed to holding to better express the function of the head piece. Applicant asserts that these amendments to claims 1 and 11 have not narrowed these claims to trigger prosecution history estoppel, but merely clarified the purposes of the elements of the combination.

Since claims 7, 9, 10, 11, 15 and 16 are indirectly dependent on claim 1, they distinguish over the cited reference in the same manner as claim 1.

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Withdrawal of the rejection of claims 7, 9, 10, 11, 15 and 16 under 35 U.S.C. §102(b) is thus respectfully requested.

**REJECTION OF CLAIM 21 UNDER 35 U.S.C. §102(b) AS BEING
ANTICIPATED BY FREITAS**

The Examiner's rejection is respectfully traversed.

The Examiner alleges that Freitas discloses the features of claim 21. Applicant disagrees with this assessment. Freitas does not show the feature that the two arms are configured with *distal end portions that are substantially transverse to the longitudinal axis*. Freitas shows no such structure. The Freitas instrument is configured as a pliers-type instrument with two arms extending *substantially in longitudinal direction*, which is exactly the opposite of the claimed head piece. When the arms in Freitas are closed as seen in Fig. 2, the arms are locked for a function described as that of a clipper, a scissors or clamp, hence the rather large engagement area of the arms. When the arms are closed, the recess in the Freitas head piece, is set back very far due to the large locking area as to be as to be unable to freely holding any microstructures, and too small for the same purpose.

The Examiner also states that *the two arms starting from the cylindrical rod in direction of the frontal face of the head piece are tapered off with opposing side walls of the taper configured in a straight shape*. As this feature is not seen from the Examiner's description, applicant has clarified the claim by reciting the

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viewing point. Accordingly, when laterally viewed, the Freitas reference does not disclose tapering arms "in a straight or arcuate shape".

In view of the above, applicant believes that claim 21 patentably distinguishes over the Freitas reference

Withdrawal of the rejection of claim 21 under 35 U.S.C. §102(b) is thus respectfully requested.

REJECTION OF CLAIMS 2-6 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SHARPE IN VIEW OF ZEITELS

The Examiner's rejection is respectfully traversed.

Zeitels teaches that at least one illuminating light guide fiber travels partly through one of the grasping arms. In another embodiment the light fibers travel through both grasping arms; or they may be affixed to the grasping jaws by conventional means. Zeitels is cited as supplying illumination to the Sharpe instrument. The Examiner however, gives no explanation of how this illuminating technique could be applied to the Sharpe instrument. There seems to be no structure disclosed in Sharpe that would permit mounting such a device into the instrument since no hint is given there providing for illumination.

Moreover, It is applicant's contention that the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re

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Gorman, 933 F.2d 982. In the case at hand, Zeitels clearly teaches the desire to lead the light fibers along the grasping arms, as discussed above in detail. There is no teaching or suggestion supporting the combination as proposed by the Examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902.

It is applicant's position that the Examiner has not shown that claims 2-6 are rendered obvious by the proposed combination of references.

Withdrawal of the rejection of claims 2-6 under 35 U.S.C. §102(b) is thus respectfully requested.

CONCLUSION

Applicant believes that when the Examiner reconsiders the claims in the light of the above comments, he will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

None of the references discloses a microsurgical instrument showing the features as claimed.

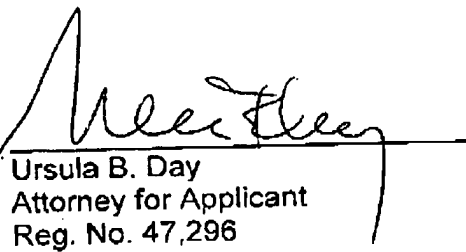
In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

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Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview. Commissioner is hereby authorized to charge fees which may be required, or credit any overpayment to Deposit Account No. 06-0502.

Respectfully submitted,

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